DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Republic of Korea on June 1, 2004. It is noted, however, that applicant has not filed a certified copy of the foreign application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The information disclosure statement (IDS) submitted on July 6, 2006 and June 18, 2009 are being considered by the examiner.

Drawings

3. The drawings were received on July 6, 2006. These drawings are acceptable.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-6 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,664,074 in view of Celedon et al. (US 2003/0190916). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

Regarding claim 1, U.S. Patent No. 7,664,074 discloses a handover method between asynchronous and synchronous mobile communication systems for a Dual Band Dual Mode (DBDM) mobile communication terminal in a mobile communication network in which the asynchronous and synchronous mobile communication systems overlap each other, the mobile communication terminal having an asynchronous modem unit and a synchronous modem unit (col. 14, lines 23-33), comprising:

the second step of the radio network controller determining whether handover is required using a blind decision method when wireless environment measurement values are less than predetermined threshold values, and informing an asynchronous

mobile switching center of the asynchronous communication system that the handover is required (col. 14, lines 34-42);

the third step of the asynchronous mobile switching center requesting handover from a synchronous mobile switching center of the synchronous communication system, and the synchronous mobile switching center assigning a forward channel to the mobile communication terminal (col. 14, lines 43-55);

the fourth step of, as the asynchronous mobile switching center directs the mobile communication terminal to perform handover, the mobile communication terminal preparing communication with the synchronous mobile communication system, and causing a backward channel with respect to the synchronous communication system to be assigned to the mobile communication terminal (col. 14, lines 56-67); and

the fifth step of the synchronous mobile switching center informing the asynchronous mobile switching center of completion of the handover, thus releasing a connection between the asynchronous mobile switching center and the radio network controller (col. 15, lines 1-9).

U.S. Patent No. 7,664,074 does not expressly disclose:

a radio network controller of the asynchronous mobile communication system periodically measuring a wireless environment around the mobile communication terminal.

In a similar endeavor, Celedon discloses a method and system for optimizing cell-neighbor lists. Celedon also discloses a radio network controller of the

asynchronous mobile communication system periodically measuring a wireless environment around the mobile communication terminal (paragraph 0008).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify U.S. Patent No. 7,664,074 and arrive at the present invention and include a radio network controller of the asynchronous mobile communication system periodically measuring a wireless environment around the mobile communication terminal.

The motivation/suggestion for doing so would have been to provide service to user without interruptions.

In addition, independent claim 1 of U.S. Patent No. 7,664,074 is more specific compare to independent claim 1 of present application. Hence, the scope of claims of present application is now broader than U.S. Patent No. 7,664,074. Many decisions support the fact that a broad or generic claim is obvious from a specific claim, i.e., an obvious variation. See In re Van Ornum and Stang, 214 USPQ 761 (CCPA 1982); In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993); In re Vogel and Vogel; 164 USPQ 619 (CCPA 1970); In re Berg (CA FC) 46 USPQ2d 1226 (3/30/1998); Eli Lilly and Co. v. Barr Laboratories Inc., 58 USPQ2d 1865 (CA FC 2001). It is well settled that omission of an element and its function in a combination is an obvious expedient if the remaining elements perform the same functions as before. This notion is supported by In re KARLSON, 136 USPQ 184 (1963); In re Nelson, 95 USPQ 82 (CCPA 1952); and In re Eliot, 25 USPQ 111 (CCPA 1935).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WAYNE CAI whose telephone number is (571)272-7798. The examiner can normally be reached on Monday-Thursday from 8:00 a.m. to 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Edouard can be reached on (571) 272-7603. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Wayne Cai/
Examiner, Art Unit 2617